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09/870,959	05/30/2001	Peter S. Banka	109887-130222	9127
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PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			EXAMINER CHEUNG, MARY DA ZHI WANG	
			ART UNIT 3621	PAPER NUMBER

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/870,959

Applicant(s)

BANKA ET AL.

Examiner

Mary Cheung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 May 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/11/02, 10/22/02.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Status of the Claims***

1. This action is in response to the application filed on May 30, 2001. Claims 1-34 are pending.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "network address translation tables 932" as described in page 24 lines 20-21 of the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective

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action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claims 33-34 are objected to because of the following informalities:

- a) In line 6 of claim 33, the phrase "and second" should be deleted to avoid a 112 2<sup>nd</sup> paragraph rejection;
- b) In line 7 of claim 33, the phrase "and second" should be deleted to avoid a 112 2<sup>nd</sup> paragraph rejection;
- c) In line 8 of claim 34, the phrase "and second" should be deleted to avoid a 112 2<sup>nd</sup> paragraph rejection;
- d) In line 9 of claim 34, the phrase "and second" should be deleted to avoid a 112 2<sup>nd</sup> paragraph rejection.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-2, 6-9, 11-14, 16, 23-25, 27-30 and 32-34 are rejected under 35

U.S.C. 102(e) as being anticipated by Kaplan et al., U. S. Patent 6,141,339.

As to claims 1, 7, 12 and 33-34 Kaplan teaches a method and a subscriber application routing device (SAR), comprising:

a storage medium having stored therein a plurality of programming instructions, and an execution unit coupled to the storage medium for executing the plurality of programming instructions (column 17 lines 14-24 and Fig. 1); and

- a) providing and receiving first one or more application service contracts by a first application service provider (Provider) to a community of one or more subscriber application routers (SAR), said first one or more application service contracts specifying subscriptions to first one or more application services provided by first one or more servers of said first Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);
- b) automatically provisioning first one or more application delivery transports to facilitate delivery of said first one or more application services provided by said first one or more servers of said first Provider to clients of said Subscriber in accordance with said first one or more application service contracts (column 6 lines 50-65 and Figs. 1, 4);
- c) providing and receiving second one or more application service contracts by a second application service provider (Provider) to the community of one or more subscriber application routers (SAR), said second one or more application service contracts specifying subscriptions to second one or more application services provided by second one or more servers of said second Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

d) automatically provisioning second one or more application delivery transports to facilitate delivery of said second one or more application services provided by said second one or more servers of said second Provider to clients of said Subscriber in accordance with said second one or more application service contracts (column 6 lines 50-65 and Figs. 1, 4);

e) delivering and receiving selected ones of said first and second application services provided by said first and second one or more servers of said first and second Providers through selected ones of said first and second application delivery transports respectively (column 4 line 43 – column 5 line 2 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claim 2, Kaplan teaches said first one or more application service contracts are provided by a community of one or more provider application routers (PARs) and said second one or more application service contracts are provided by a second community of one or more PARs (column 4 lines 39-43 and column 8 line 41 – column 9 lines 6 and Fig. 1).

As to claims 6, 27 and 32, Kaplan teaches at least one of said first one or more application delivery transports and said second one or more application delivery transports comprise one or more virtual private network tunnels (column 3 lines 59 – column 4 line 7 and column 6 line 33 – column 7 line 25).

As to claims 8 and 13, Kaplan teaches said SAR solicits said first one or more application service contracts from said first provider (column 4 line 43 – column 5 line 2 and Fig. 1).

As to claims 9 and 14, Kaplan teaches said first one or more application service contracts are received from said first provider through an encrypted control channel (column 8 lines 6-11 and column 9 lines 46-49).

As to claims 11 and 16, Kaplan teaches said automatically provisioning said first one or more application delivery transports comprises automatically provisioning a first one or more virtual private network tunnels between said SAR and said first provider (column 3 lines 59 – column 4 line 7 and column 6 line 33 – column 7 line 25).

As to claims 23 and 28, Kaplan teaches in a provider application routing device (PAR), a method comprising:

a storage medium having stored therein a plurality of programming instructions, and an execution unit coupled to the storage medium for executing the plurality of programming instructions (column 17 lines 14-24 and Fig. 1); and

a) providing first one or more application service contracts to a first community of one or more subscriber application routers (SAR), said first one or more application service contracts specifying subscriptions to first one or more application services provided by first one or more servers of said Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

b) providing second one or more application service contracts to a second community of one or more subscriber application routers (SAR), said second one or more application service contracts specifying subscriptions to second one or more application services provided by second one or more servers of said Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

c) delivering selected ones of said first and second application services provided by said first and second one or more servers of said Provider through selected ones of a first one or more application delivery transports provisioned between said first community of one or more SARs and said PAR and a second one or more application delivery transports provisioned between said second community of one or more SARs and said PAR (column 4 line 43 – column 5 line 2 and column 8 line 41 – column 9 line 6 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claims 24 and 29, Kaplan teaches the selected ones of said first and second application services are delivered to one or more clients of said first community of one or more SARs (column 4 line 43 – column 5 line 2 and column 8 line 41 – column 9 line 6 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claims 25 and 30, Kaplan teaches said PAR is one of a community of PARs (column 4 line 43 – column 5 line 2 and Fig. 1).

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were



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made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Gubbi et al., U. S. Patent 5,677,905 and Bellwood et al., U. S. Patent 6,584,567.

As to claim 3, Kaplan teaches said automatically provisioning first one or more application delivery transports further comprises: identifying, by a first SAR of said community of one or more SARs, a preferred PAR of said first community of one or more PARs (column 4 line 23 – column 5 line 2 and column 6 lines 33-61). Kaplan does not specifically teach negotiating a subnet and a shared secret between said first SAR and said preferred PAR to facilitate provisioning of said first one or more delivery transports. Gubbi teaches negotiating a subnet between subscriber and provider (column 9 lines 5-18 and column 12 lines 8-14), and Bellwood teaches negotiating a shared secret between subscriber and provider (column 4 lines 1-24). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of negotiating subnet and shared secret between subscriber and provider for providing the ultimate best contract for both the subscriber and the provider.

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9. Claims 4, 10 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Gubbi et al., U. S. Patent 5,677,905.

As to claim 4, Kaplan teaches providing first one or more application service contracts to a community of one or more SAR(s) as discussed above. Kaplan does not specifically teach providing one or more unapproved service contracts to a community of one or more SAR(s) for approval by the SAR(s). However, this matter is taught by Gubbi as providing, negotiating and approving contracts between two devices (column 8 line 61 – column 9 line 18 and column 12 lines 25-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of providing contracts for subscriber's approval for ensuring subscriber's satisfaction of the contracts.

As to claims 10 and 15, Kaplan teaches receiving first one or more application service contracts from the first application service provider as discussed above. Kaplan does not specifically teach approving at least a subset of said first one or more application service contracts received from said first provider, and transmitting said approved one or more application service contracts back to said first provider. However, Gubbi teaches providing, negotiating and approving at least a subnet and transmitting the approved contract back to the provider (column 8 line 61 – column 9 line 18 and column 12 lines 8-45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of approving at least a subnet and transmitting the approved contract back to the provider for ensuring subscriber and provider's satisfaction of the contracts.

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10. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Gubbi et al., U. S. Patent 5,677,905, and in further view of Asay et al., U. S. Patent 5,903,882.

As to claim 5, Kaplan modified by Gubbi teaches providing one or more unapproved service contracts to a community of one or more SAR(s) for approval by the SAR(s) as discussed in claim 4 above. Kaplan modified by Gubbi does not specifically teach said community of one or more SAR(s) approves said one or more unapproved service contracts through manifestation of a digital signature by the approving SAR(s). However, Assay teaches using digital signatures for approving transactions (column 1 line 53 – column 2 line 20). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow the teaching of Kaplan modified by Gubbi to include the feature of using digital signatures for approving the contracts for better securing the contract approving process.

11. Claims 17-22, 26 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan et al., U. S. Patent 6,141,339 in view of Li, U. S. Patent 6,707,796.

As to claims 17 and 20, Kaplan teaches in a subscriber application routing device (SAR), comprising:

a storage medium having stored therein a plurality of programming instructions, and an execution unit coupled to the storage medium for executing the plurality of programming instructions (column 17 lines 14-24 and Fig. 1); and  
a) receiving one or more application service contracts from an application service provider (Provider), said one or more application service contracts

specifying subscriptions to one or more application services provided by one or more servers of said Provider (column 3 lines 9-27 and column 6 lines 34-61 and Figs. 1, 4);

b) automatically provisioning one or more application delivery transports between said SAR and a selected one or more of PARs to facilitate delivery of said one or more application services provided by said one or more servers of said Provider to clients of said Subscriber in accordance with said one or more application service contracts (column 6 lines 50-65 and Figs. 1, 4);

c) receiving selected ones of said application services provided by said one or more servers of said Provider through selected ones of said application delivery transports respectively (column 4 line 43 – column 5 line 2 and column 11 line 19 – column 12 line 9 and Figs. 1, 7).

As to claims 17, 20, 26 and 31, Kaplan does not specifically teach request from the Provider a list of provider application routers (PARs) identified as being able to support a given contract of said one or more application service contracts. However, Li teaches providing a list of routers that the system supports (column 10 lines 1-17). It would have been obvious to one of ordinary skill in the art at the time the invention was made to allow Kaplan's teaching to include the feature of providing a list of validated PARs because this would allow the subscribers or other users to make an easy and better decision to select PARs.

As to claims 26 and 31, Kaplan modified by Li does specifically teach notifying said first community of one or more SARs as to which PARs are able to support the

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selected one of said first one or more application service contracts. It would have been obvious to one of ordinary skill in the art to allow the teaching of Kaplan modified by Li to include the feature of notifying the SARs as claimed for reducing the confusion of which routers to be used.

As to claims 18 and 21, Kaplan modified by Li does not specifically teach said selected one or more of said listed PARs are selected by the SAR based at least in part upon response times of the respective PARs. It would have been obvious to one of ordinary skill in the art to allow the teaching of Kaplan modified by Li to include selecting PARs within the response times for efficient allocation of the routers.

As to claims 19 and 22, Kaplan teaches wherein automatically provisioning one or more application delivery transports comprises establishing one or more virtual private network tunnels between said SAR and said selected one or more PARs (column 3 lines 59 – column 4 line 7 and column 6 line 33 – column 7 line 25).

### ***Conclusion***

12. Examiner has pointed out particular references contained in the prior arts of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hummel, Jr. et al. (U. S. Patent 6,584,464) discloses delivery of protected software application to remote systems from a central service facility.

***Inquire***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary Cheung whose telephone number is (703)-305-0084. The examiner can normally be reached on Monday – Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell, can be reached on (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

The fax phone number for the organization where this application or proceedings is assigned are as follows:

(703) 872-9306 (Official Communications; including After Final  
Communications labeled "BOX AF")

(703) 746-5619 (Draft Communications)

Hand delivered responses should be brought to Crystal Plaza Two, Room 1B03.

Mary Cheung  
Patent Examiner  
Art Unit 3621  
July 26, 2004

